

REMARKS

Upon entry of the present amendment, claims 1-24 are pending in the application.

The limitation "using the apparatus of claim 10" has been added to claim 1 to emphasize the special technical feature common to claims 1 and 10. Support is at least on p. 5, ll. 6-20, of the application as filed.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, he is invited to call the telephone number below for an interview.

1. **Restriction Requirement Under 35 U.S.C. §121/372**

It is the PTO's position that restriction is required between the inventions of Group I, claims 1-9, drawn to a process for producing powder coating materials, and Group II, claims 10-24, drawn to a Taylor reactor. Restriction is said to be appropriate on the grounds that the claims lack unity of invention. In particular, the PTO states

The inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: WO 00/00280 (Moritz) teaches a Taylor Reactor having the claimed features in applicant claim 10 . . . Where there is an inlet region (6), an outlet (7), a homogenizing means (2). The product is discharged through the outlet (7). For

this reason the Taylor Reactor of claim 10 cannot be considered an inventive concept.

(Office Action of January 28, 2009, p. 2)

Applicants greatly appreciate the PTO's detailed comments but must respectfully disagree and traverse the restriction requirement. The PTO has incorrectly characterized the invention of Group II as being drawn to a Taylor reactor. The invention of Group II is drawn instead to an apparatus for implementing the process of claim 1, and comprises a Taylor reactor *and a homogenizing means (16)*.

The PTO has also not correctly identified the special technical feature that makes a contribution over the prior art. The special technical feature is *not* a Taylor reactor *per se*. Rather, at least one special technical feature common to independent claims 1 and 10 is the "homogenizing means (16) which comprises at least one first and second inlets for supplying the polyaddition resin melt delivered by the Taylor reactor, and the crosslinker, and also comprising an outlet via which a product is delivered by the homogenizing means (16)."

The PTO incorrectly relates the rotor (2) of the Taylor reactor of Moritz with the homogenizing means (16) of the instant claims. The rotor (2) of Moritz cannot be the homogenizing means (16) of the instant claims because the homogenizing means must be external to the Taylor reactor. According to the instant claims, the homogenizing means comprises inlets for supplying the resin melt *delivered by the Taylor reactor*. Therefore the homogenizing means (16) cannot be part of the Taylor reactor itself. Moreover Figure 1 of the instant application definitively shows that homogenizing means 16 is *not* the same as rotor (2).

For this reason, it is respectfully submitted that the limitation of "homogenizing means (16) which comprises at least one first and second inlets for supplying the polyaddition resin melt delivered by the Taylor reactor, and the crosslinker, and also comprising an outlet via which a product is delivered by the homogenizing means (16)" is a "special technical feature" as that term is defined in MPEP 1893.03(d), i.e. meaning a technical feature that defines the contribution which each claimed invention, considered as a whole, makes over the prior art.

Moreover, independent claims 1 and 10 are not anticipated by Moritz. There is no disclosure in Moritz of a "homogenizing means (16) which comprises at least one first and second

inlets for supplying the polyaddition resin melt delivered by the Taylor reactor, and the crosslinker, and also comprising an outlet via which a product is delivered by the homogenizing means (16).” The rotor (2) taught by Moritz does not correspond to this claim limitation because it is an internal component of the Taylor reactor itself.

In view of the arguments set forth above, it is respectfully submitted that the PTO has failed to establish any record that Applicants' special technical feature is disclosed in the cited art, and therefore unity of invention does exist for the claims as currently amended. Accordingly, restriction is not permissible under 37 CFR 1.499. Reconsideration and removal of the restriction requirement is respectfully requested.

However, per the requirements of 37 CFR 1.499 and 37 CFR 1.143, Applicants hereby elect the invention of Group II, claims 10-24 drawn to an apparatus for implementing the process of Group I, comprising both a Taylor reactor and homogenizing means, with traverse. If the restriction requirement is maintained, Applicants hereby authorize the withdrawal of claims 1-9 as being drawn to a nonelected invention.

CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

Friday, December 11, 2009
CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
WYANDOTTE, MI 48192
Customer No. 77224

MEG/DJJ